

RECEIVED

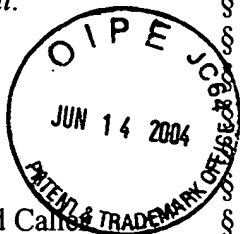
JUN 1 8 2004

Group Art Unit: 2645

Technology Center 2600

Examiner: Elahee, Md S

Atty Docket No.: AUS920010818US1



Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on

June 10, 2004

Date Catherine A. Berglund

Catherine A. Berglund

Honorable Commissioner:

This is an Appeal Brief filed in response to the Final Office Action of March 10, 2004.

REAL PARTY IN INTEREST

The real party in interest is the patent assignee, International Business Machines Corporation ("IBM"), a New York corporation having a place of business at Armonk, New York 10504.

RELATED APPEALS AND INTERFERENCES

RECEIVED

JUN 18 2004

Technology Center 2600

There are no related appeals or interferences.

STATUS OF CLAIMS

The pending claims are claims 31-41. Claims 31-33, 35-37, 39 and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McAllister et al. (U.S. Patent No. 6,442,242). Claims 34, 38 and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over McAllister et al. (U.S. Patent No. 6,442,242) and in view of Kawahara et al. (U.S. Pub. No. 2002/0184096). All pending claims are on appeal.

STATUS OF AMENDMENTS

No amendments were submitted after final rejection. The claims as currently presented are included in the Appendix of Claims as amended in response to an Office Action dated July 16, 2003.

SUMMARY OF INVENTION

Applicants provide the following concise summary of the invention according to 37 CFR 1.192(c) (5). Methods, systems, and computer program products are provided for specifying telephone services for a particular caller. Embodiments include receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile described for example with reference to Figure 4, steps 1-6 at pages 31, line 5- page 33, line 5, page 14, lines 5 - 15; page 20, lines 21 - page 22, line 20; and page 25, line 1 - page 26, line 5.

ISSUES

The issues before the board generally are whether the claims are properly rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 103. More particularly, the issues are:

1. Whether McAllister discloses each and every element and limitation of the claims of the present application.
2. Whether McAllister provides an enabling disclosure of each and every element and limitation of the claims of the present invention.
3. Whether the combination of McAllister and Kawahara establishes a prima facie case of obviousness.

GROUPING OF CLAIMS

The claims do not stand or fall together. More particularly, if the independent claims stand, then the dependent claims stand together with them. The independent claims, however, fall separately. The claims include three independent claims (claims 31, 35, and 39) each of which has depending from it a group of dependent claims (claims 32-34, 36-38, and 40-41 respectively). The independent claims 31, 35, and 39 claim respectively method, system, and product aspects of for specifying telephone services for a particular caller. If the independent claims stand, all the claims stand. Moreover, because the independent claims claim respectively method, system, and product aspects of the present invention, the independent claims all stand if claim 1 stands. If the independent claims fall, however, the dependent claims may still be patentable individually.

ARGUMENT

Applicants argue in summary:

1. McAllister does not disclose each and every element of the claims of the present invention.
2. McAllister is not an enabling disclosure of the claims of the present invention.
3. The combination of McAllister and Kawahara does not establish a prima facie case of obviousness.

Claims Rejections – 35 U.S.C. 102(e)

Claims 31-33, 35-37, 39 and 40 stand rejected under 35 U.S.C. § 102(e) as being anticipated by McAllister *et al.* (U.S. Patent No. 6,442,242). To anticipate the claims of the present invention under 35 U.S.C § 102(e), two requirements must be met. The first requirement of anticipation is that McAllister must disclose each and every element as set forth in Applicants' claims. The second requirement of anticipation is that McAllister must enable Applicants' claims. McAllister does not meet either requirement and therefore does not anticipate Applicants' claims.

McAllister Does Not Disclose Each and Every Element of Applicants' Claims

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). McAllister does not teach each and every element of claims 31-33, 35-37, 39 and 40. The rejection should therefore be withdrawn and the claims should be allowed.

Independent claim 31 recites a “method for specifying telephone services for a particular caller” including “receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.” McAllister does not disclose “specifying telephone services for a particular caller” as claimed in independent claim 31. In fact, McAllister does not even mention telephone services for a particular caller. Instead, McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. McAllister does not however disclose specifying telephone services and therefore does not teach each and every element of independent claim 31. The rejection should be withdrawn.

McAllister also does not disclose “receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device.” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister, column 1, line 7; column 2, lines 29-30; column 5, lines 32-67. A spoken name is not an authenticated caller identity. McAllister does not disclose authenticating the spoken name. In fact, McAllister does not even mention authentication. McAllister therefore does not teach each and every element of independent claim 31 and the rejection should be withdrawn.

McAllister also does not disclose “retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. McAllister discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing. McAllister, column 7, lines 17-32. McAllister describes subscriber-specific information appropriate to a

particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. McAllister does not disclose specifying telephone services and therefore does not disclose “specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. McAllister therefore does not teach each and every element of independent claim 31 and the rejection should be withdrawn.

Independent claims 35 and 39 claim a system and computer program product that correspond to the method claim of claim 31. Independent claim 35 claims a “system for specifying telephone services for a particular caller” and independent claim 39 claims a “computer program product for specifying telephone services for a particular caller.” As discussed above, McAllister does not disclose “specifying telephone services for a particular caller.” McAllister therefore cannot disclose a system or computer program product for specifying telephone services for a particular caller. For the same reasons that McAllister does not disclose each and every element of claim 31, McAllister does not disclose each and every element of corresponding claims 35 and 39 and their rejection should be withdrawn.

Claims 32-34, 36-38, and 40-41 depend from independent claims 31, 35, and 39 respectively and include all of the limitations of the claims from which they depend. Because McAllister does not disclose each and every element of independent claims 31, 35, and 39, McAllister does not disclose each and every element of dependent claims 32-34, 36-38, and 40-41. Their rejection should therefore be withdrawn.

McAllister Is Not An Enabling Disclosure of Applicants’ Claims

Not only must McAllister disclose each and every element of the claims of the present invention within the meaning of *Verdegaal* in order to anticipate claims 31-41, but also McAllister must be an enabling disclosure of claims 31-41 within the meaning of *In re Hoeksema*. In *Hoeksema*, the claims were rejected because an earlier patent disclosed a

structural similarity to the applicant's chemical compound. The court in *Hoeksema* stated: "We think it is sound law, consistent with the public policy underlying our patent law, that before any publication can amount to a statutory bar to the grant of a patent, its disclosure must be such that a skilled artisan could take its teachings in combination with his own knowledge of the particular art and be in possession of the invention." *In re Hoeksema*, 399 F.2d 269, 273, 158 USPQ 596, 600 (CCPA 1968). The meaning of *Hoeksema* for the present case is that unless McAllister places Applicants' claims in the possession of a person of ordinary skill in the art, McAllister is legally insufficient to anticipate Applicants' claims under 35 USC 102(e). As shown below, McAllister's description of telephone auto attendant systems and subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager is legally insufficient to place claims 31-41 in the possession of a person of ordinary skill in the art.

Independent claim 31 recites a "method for specifying telephone services for a particular caller" including "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile." McAllister does not enable "specifying telephone services for a particular caller" as claimed in independent claim 31. In fact, McAllister does not even mention telephone services for a particular caller. Instead, McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. McAllister therefore does not place one of skill in the art in possession of specifying telephone services as claimed in claim 31. McAllister therefore does not enable independent claim 31 and the rejection should be withdrawn.

McAllister also does not enable "receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device. . . ." McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a

subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister, column 1, line 7; column 2, lines 29-30; column 5, lines 32-67. A spoken name is not an authenticated caller identity. McAllister does not disclose authenticating the spoken name. In fact, McAllister does not even mention authentication. McAllister therefore does not place one of skill in the art in possession of independent claim 31 and therefore is legally insufficient to enable claim 31. The rejection should be withdrawn.

McAllister also does not enable “retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. McAllister discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing. McAllister, column 7, lines 17-32. McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. McAllister does not disclose specifying telephone services and therefore does not disclose “specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. McAllister therefore does not place one of skill in the art in possession of independent claim 31 and is legally insufficient to enable claim 31. The rejection should be withdrawn.

Independent claims 35 and 39 claim a system and computer program product that correspond to the method claim of claim 31. Independent claim 35 claims a “system for specifying telephone services for a particular caller” and independent claim 39 claims a “computer program product for specifying telephone services for a particular caller.” As discussed above, McAllister does not enable “specifying telephone services for a particular caller.” McAllister therefore cannot enable a system or computer program product for specifying telephone services for a particular caller. For the same reasons

that McAllister does not enable claim 31, McAllister does not enable corresponding claims 35 and 39 and their rejection should be withdrawn.

Claims 32-34, 36-38, and 40-41 depend from independent claims 31, 35, and 39 respectively and include all of the limitations from which they depend. Because McAllister does not enable independent claims 31, 35, and 39, McAllister does not enable dependent claims 32-34, 36-38, and 40-41. Their rejection should therefore be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 34, 38, and 41 stand rejected under 35 U.S.C § 103(a) as unpatentable over McAllister in view of Kawahara (U.S. Patent Application No., 2002/0184096). The proposed combination of McAllister and Kawahara cannot establish a prima facie case of obviousness. To establish a prima facie case of obviousness, three basic criteria must be met. Manual of Patent Examining Procedure §2142. First, the combination must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). Second, there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). Finally, there must be a reasonable expectation of success in the combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986). The combination of McAllister and Kawahara does not meet a single criteria required to establish a prima facie case of obviousness. The rejection should therefore be withdrawn and the case should be allowed.

**Combination of McAllister and Kawahara Does Not Teach or Suggest
All of Applicants' Claim Limitations**

The combination of McAllister and Kawahara does not teach or suggest all of Applicants' claim limitations. Rejected claims 34, 38, and 41 depend from claims 31, 35, and 39 claim methods, systems, and products for "specifying telephone services for a particular caller" including "receiving, at an intermediary device, an authenticated caller

identity for a call request from an origin device; retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.” Neither McAllister nor Kawahara disclose “specifying telephone services for a particular caller” as claimed in independent claim 31. In fact, McAllister does not even mention telephone services for a particular caller. Instead, McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Kawahara has nothing to do with specifying telephone services for a particular caller. The combination of McAllister and Kawahara therefore does not disclose each and every element of claims 31-41 and therefore cannot establish a prima facie case of obviousness. The rejection should therefore be withdrawn.

Neither McAllister nor Kawahara disclose “receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device. . . .” McAllister describes telephone auto attendant systems including a telephone directory for routing calls to a subscriber by receiving the spoken name of a called party, retrieving a telephone number for that called party and forwarding the telephone number of the called party to a PBX to complete the call. McAllister, column 1, line 7; column 2, lines 29-30; column 5, lines 32-67. A spoken name is not an authenticated caller identity. McAllister does not disclose authenticating the spoken name. In fact, McAllister does not even mention authentication. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Kawahara has nothing to do with specifying telephone services for a particular caller or authenticating a caller identity. The combination of McAllister and Kawahara therefore does not disclose each and every element of claims 31-41 and therefore cannot establish a prima facie case of obviousness. The rejection should therefore be withdrawn.

Neither McAllister nor Kawahara disclose “retrieving a caller profile for said authenticated caller identity; and specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. McAllister discloses receiving a spoken caller name and retrieving subscriber-specific information to initiate subscriber-specific processing. McAllister, column 7, lines 17-32. McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55-column 8, line 10. McAllister does not disclose specifying telephone services and therefore does not disclose “specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Kawahara has nothing to do with specifying telephone services for a particular caller or “specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile” as claimed independent claim 31. The combination of McAllister and Kawahara therefore does not disclose each and every element of claims 31-41 and therefore cannot establish a prima facie case of obviousness. The rejection should therefore be withdrawn.

No Suggestion or Motivation to Combine McAllister and Kawahara

There is no suggestion or motivation to combine McAllister and Kawahara. The suggestion or motivation to combine McAllister and Kawahara must come from the teaching of the references themselves and the Examiner must explicitly point to the teaching McAllister and Kawahara suggesting the proposed combination. Absent such a showing, the Examiner has impermissibly used “hindsight” occasioned by Applicants’ own teaching to reject the claims. *In re Surko*, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck*, 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re*

Gorman, 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski*, 871 F.,2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). The Examiner has not demonstrated any teaching in either McAllister or Kawahara suggesting their combination. The two references are unrelated and neither McAllister nor Kawahara even mention telephone services for a particular caller as claimed in claims 31-41. McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. As such, there is no suggestion or motivation to combine McAllister and Kawahara and the proposed combination cannot support a prima facie case of obviousness. The rejection should therefore be withdrawn.

**No Reasonable Expectation of Success in the Proposed Combination
Of McAllister and Kawahara**

There is also no reasonable expectation of success in the proposed combination of McAllister and Kawahara. McAllister describes subscriber-specific information appropriate to a particular product related service being requested such as ordering a replacement battery for a pager. McAllister, column 6 lines 30-40; column 7, line 55- column 8, line 10. Kawahara is an unrelated disclosure of a portable terminal device aimed at immediately providing a consumer with advertising information about goods that the consumer finds on another person. Kawahara, paragraph 0002, paragraph 0014. Combining the subscriber-specific information of McAllister with the portable terminal device for advertising of Kawahara will not work to specify telephone services as claimed in claims 31-41 because the combination of McAllister and Kawahara would instead result in subscriber-specific information that immediately provides advertising information. The proposed combination of McAllister and Kawahara therefore cannot support a prima facie case of obviousness and the rejection should be withdrawn.

The Four Factual Inquires Required By The Supreme Court For An Obviousness Rejection Have Not Been Properly Considered, Determined, and Applied

Establishing a prima facie case of obviousness for claims 34, 38, and 41, which has not been accomplished, is not the end of obviousness analysis, it is the beginning. The rejection of these claims under 35 U.S.C. § 103 are deficient because the proper factual inquiries have not been considered, determined, and applied as required by the Supreme Court in *Graham v. John Deere*. The rejection should therefore be withdrawn and the case allowed.

The Manual of Patent Examining Procedure §2141 explicitly states:

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case. The Supreme Court in *Graham v. John Deere*, 383 U.S. 1, 148 USPQ 459 (1966), stated:

Under Section 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . .

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

Office policy has consistently been to follow *Graham v. John Deere Co.* in the consideration and determination of obviousness under 35 U.S.C. 103. As quoted above, the four factual inquiries enunciated therein as a background for determining obviousness are briefly as follows:

- (A) Determining of the scope and contents of the prior art;
- (B) Ascertaining the differences between the prior art and the claims in issue;
- (C) Resolving the level of ordinary skill in the pertinent art; and
- (D) Evaluating evidence of secondary considerations.

Manual of Patent Examining Procedure §2141.

In over two years of prosecution the Examiner has yet to even mention the four factual inquiries required by the Supreme Court in *Graham v. John Deere*, and all four factual inquiries have not been properly considered, determined, and applied in any of the office actions in this case.

The first factual inquiry that has not been properly considered and determined is ascertaining the differences between the prior art and the claims in issue. More particularly, in the office action of March 10, 2004, the Examiner has only identified elements in Applicants' claims not found in McAllister then attempted to find a similar element in Kawahara to support an obviousness rejection. Such analysis is improper and incomplete. "Ascertaining the differences between the prior art and the claims at issue requires interpreting the claim language, and considering both the invention and the prior art references as a whole." MPEP §2141.02. Furthermore, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *Id.*, citing *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530 (Fed. Cir. 1983). The office action of March 10, 2004, is therefore deficient because the Examiner has only identified differences between Applicants claims, McAllister and Kawahara. This analysis is improper and incomplete because Examiner has not determined whether Applicants claims as a whole would have been

obvious in view of a combination of McAllister and Kawahara as required by the Manual of Patent Examining Procedure. As such, the obviousness rejections should be withdrawn and the case should be allowed.

The second factual inquiry that has not been properly considered, determined, and applied is resolving the level of ordinary skill in the pertinent art. "The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry." MPEP §2141.03 citing *Ryko Mfg. Co. v. Nu-Star, Inc.*, 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991). "The examiner must ascertain what would have been obvious to one of ordinary skill in the art at the time the invention was made, and not to the inventor, a judge, a layman, those skilled in remote arts, or to geniuses in the art at hand." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). "Factors that may be considered in determining level of ordinary skill in the art include (1) the educational level of the inventor; (2) type of problems encountered in the art; (3) prior art solutions to those problems; (4) rapidity with which innovations are made; (5) sophistication of the technology; and (6) educational level of active workers in the field." *Id.* citing *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 696, 218 USPQ 865, 868 (Fed. Cir. 1983), cert. denied, 464 U.S. 1043 (1984). The office actions of April 24, 2003, October 8, 2003, and March 10, 2004 fail to apply a single factor to consider in determining the level of ordinary skill in the art. In fact, in over two years of prosecution and three office actions, no analysis at all considering the level of one of ordinary skill in the art for the instant case has been performed. The rejection is therefore deficient and the case should be allowed.

CONCLUSION

McAllister does not teach each and every element of Applicants' claims and does not enable Applicants' claims. McAllister therefore does not anticipate claims 31-41 in the present application. The proposed combinations of McAllister and Kawahara also fail to establish a prima face case of obviousness because the proposed combination does not

teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. The rejections under 35 U.S.C. § 103 are also deficient because the factual inquiries necessary to determine obviousness have not been considered, determined, and applied. Applicants respectfully request the allowance of claims 31-41.

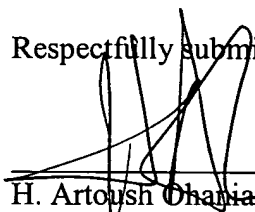
In view of the forgoing arguments, reversal on all grounds of rejection is requested.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Date: 6.10.04

By:

Respectfully submitted,



H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, LLP
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPELLANTS

APPENDIX OF CLAIMS
ON APPEAL IN PATENT APPLICATION OF
MICHAEL WAYNE BROWN, SERIAL NO. 10/015,381

CLAIMS

What is claimed is:

31. A method for specifying telephone services for a particular caller, comprising:

receiving, at an intermediary device, an authenticated caller identity for a call request from an origin device;

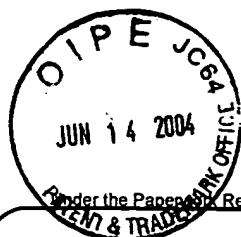
retrieving a caller profile for said authenticated caller identity; and

specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
32. The method for specifying telephone services for a particular caller according to claim 31, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
33. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:

retrieving said caller profile from a profile database within said intermediary device.

34. The method for specifying telephone services for a particular caller according to claim 31, wherein retrieving a caller profile further comprises:
- retrieving said caller profile from a systems management server.
35. A system for specifying telephone services for a particular caller, comprising:
- an intermediary device communicatively connected to a telephone network;
- means for receiving, at said intermediary device, an authenticated caller identity for a call request from an origin device;
- means for retrieving a caller profile for said authenticated caller identity; and
- means for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
36. The system for specifying telephone services for a particular caller according to claim 35, wherein said authenticated caller identity is authenticated by a voice utterance of said caller.
37. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:
- means for retrieving said caller profile from a profile database within said intermediary device.
38. The system for specifying telephone services for a particular caller according to claim 35, wherein retrieving a caller profile further comprises:

- means for retrieving said caller profile from a systems management server.
39. A computer program product for specifying telephone services for a particular caller, comprising:
- a recording medium;
- means, recorded on said recording medium, for receiving an authenticated caller identity for a call request from an origin device;
- means, recorded on said recording medium, for retrieving a caller profile for said authenticated caller identity; and
- means, recorded on said recording medium, for specifying a selection of services from among a plurality of services that are offered for said call request according to said caller profile.
40. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a profile database within said intermediary device.
41. The computer program product for specifying telephone services for a particular caller according to claim 39, further comprising:
- means, recorded on said recording medium, for retrieving said caller profile from a systems management server.



AF2600

PTO/SB/21 (03-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/015,381	RECEIVED JUN 18 2004 Technology Center 2600
	Filing Date	12/12/2001	
	First Named Inventor	Michael Wayne Brown	
	Art Unit	2645	
	Examiner Name	Elahee, MD S	
Total Number of Pages in This Submission	264	Attorney Docket Number	AUS920010818US1

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to a Technology Center (TC) <input checked="" type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Postcard; Appeal Brief & 2 Copies (19 pages each);
Remarks Enclosures (cont): 2 References (3 copies) (207 pages) The Commissioner is authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual	H. Artoush Ohanian Reg. No. 42,022
Signature	
Date	06/10/04

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231 on this date: 06/10/04	
Typed or printed	Catherine Berglund
Signature	
Date	06/10/04

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, Washington, DC 20231.

If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.